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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,792	12/22/1999	CHARLES ROBERT KALMANEK JR.	2685/5249	5384

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EXAMINER	
TON, DANG T	

ART UNIT	PAPER NUMBER
2666	

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/469,792	KALMANEK ET AL.	
	Examiner	Art Unit	
	DANG T. TON	2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-23,26,28-30,32-37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albers et al. (6,078,648) in view of Murthy et al. (5,610,905).

For claims 21-23,26,28-30,32-37, and 40 , Albers et al. disclose advanced intelligent network functionality for electronic surveillance comprising :

verifying, on a per-call basis, that a call associated with a first party (see target location) is to be surveilled (see column 3 lines 53-57);

transmitting packets associated with the call to a second party (see FBI in column 6 lines 62-64) and to a surveillance receiver;

wherein the call includes a bearer channel (see column 10 lines 47-48),

the transmitted packets are only those packets associated with the bearer channel of the call (see column 3 lines 53-57);

receiving a request for surveillance of calls associated with the first party (see column 3 lines 53-57);

sending a surveilling message to the surveillance receiver after verifying for the call and before transmitting packets to the surveillance receiver (see column 3 lines 53-57),

the surveilling message indicating an address of the first party and an address of the second party (see column 7 lines 55-58);

receiving a gate open message having an address of a surveillance receiver associated with a first party, the gate open message associated with one call between the first party and a second party (see column 3 lines 53-57 and column 7 lines 55-58);

transmitting packets associated with the one call to: i) the surveillance receiver based on the surveillance receiver address, and ii) at least one from the group of the first party and the second party (see column 3 lines 53-58);

sending, from a surveillance receiver, a request for surveillance of calls associated with a first party;

receiving packets associated with a call between the first party and a second party, the received packets being multicast from a network edge device to the second party and the surveillance party (see target location, FBI location and column 3 lines 53-57);

wherein the network edge device is associated with the first party (see target location);

wherein the network edge device is associated with the second party (see FBI location);

receiving a surveillance message before receiving the transmitted packets from the network edge device (see column 3 lines 53-57),

the surveillance message indicating an address associated with the first party and an address associated with the second party(see column 7 lines 55-58);

wherein verification that a call associated with the first party is to be surveilled, and
is performed on a per-call basis and based on the sent surveillance request (see column 3 lines 53-57).

For claims 21-23,26,28-30,32-37, and 40, Albers et al. disclose all the subject matter of the claimed invention with the exception of multicasting packets with the call to a second party in a communications network. Murthy et al. from the same or similar fields of endeavor teaches a provision of a packet being intended a multicast destination address being received (see column 5 lines 64-66). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use multicasting packets as taught by Murthy et al. in the communications network of Albers et al. The multicasting packets as taught by Murthy et al. can be implemented/modified into the network of Albers et al by multicasting packets from the target location address to the FBI location address. The

motivation for using the multicasting packets being that it provides lawfully authorized electronic surveillance service in a public switched telephone system.

3. Claims 24,25,27,38 ,and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albers et al. (6,078,648) in view of Murthy et al. (5,610,905)and further in view of Kalmanek et al. (6,757,290).

For claims 24,25,27,38 ,and 39, Albers et al. and Murthy et al. disclose all the subject matter of the claimed invention with the exception of both first and second party being untrusted and packets associated with the call connecting a trusted network to an untrusted network in a communications network. Kalmanek et al. from the same or similar fields of endeavor teaches a provision of both first and second party being untrusted and packets associated with the call connecting a trusted network to an untrusted network (see column 12 lines 25-31). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use both first and second party being untrusted and packets associated with the call connecting a trusted network to an untrusted network as taught by Kalmanek et al. in the

communications network of ALbers et la. The first and second party being untrusted can be implemented/modified into the network of Albers et al by designating the target location and the FBI location being untrusted locations. The motivation for using the both first and second party being untrusted and packets associated with the call connecting a trusted network to an untrusted network being that it provides lawfully authorized electronic surveillance service in a public switched telephone system and designating which location being trusted or untrusted location.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts et al in view of Murthy et al. and further in view of Elliott et al. (6,614,781).

For claim 31, Albers et al. disclose advanced intelligent network functionality for electronic surveillance comprising :

verifying, on a per-call basis, that a call associated with a first party (see target location) is to be surveilled (see column 3 lines 53-57);

transmitting packets associated with the call to a second party (see FBI in column 6 lines 62-64) and to a surveillance receiver;

wherein the call includes a bearer channel (see column 10 lines 47-48),

the transmitted packets are only those packets associated with the bearer channel of the call (see column 3 lines 53-57);

receiving a request for surveillance of calls associated with the first party (see column 3 lines 53-57);

sending a surveilling message to the surveillance receiver after verifying for the call and before transmitting packets to the surveillance receiver (see column 3 lines 53-57),

the surveilling message indicating an address of the first party and an address of the second party (see column 7 lines 55-58);

receiving a gate open message having an address of a surveillance receiver associated with a first party, the gate open message associated with one call between the first party and a second party (see column 3 lines 53-57 and column 7 lines 55-58);

transmitting packets associated with the one call to: i) the surveillance receiver based on the surveillance receiver

address, and ii) at least one from the group of the first party and the second party (see column 3 lines 53-58);

sending, from a surveillance receiver, a request for surveillance of calls associated with a first party;

receiving packets associated with a call between the first party and a second party, the received packets being multicast from a network edge device to the second party and the surveillance party (see target location, FBI location and column 3 lines 53-57);

wherein the network edge device is associated with the first party (see target location);

wherein the network edge device is associated with the second party (see FBI location);

receiving a surveillance message before receiving the transmitted packets from the network edge device (see column 3 lines 53-57),

the surveillance message indicating an address associated with the first party and an address associated with the second party(see column 7 lines 55-58);

wherein verification that a call associated with the first party is to be surveilled, and

is performed on a per-call basis and based on the sent surveillance request (see column 3 lines 53-57).

For claim 31, Albers et al. and Murthy et al. disclose all the subject matter of the claimed invention with the exception of QOS indicator in a communications network. Elliott et al. from the same or similar fields of endeavor teaches a provision of the QOS (see column 76 lines 43-52). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the QOS as taught by Elliott et al. in the communications network of Albers et al and Murthy et al. The QOS as taught by Elliott et al. can be implemented/modified into the network of Albers et al by using the SCP to control the QOS. The motivation for using the QOS being that it provides the system more reliable since it controls the service of the calls.

6. Applicant's arguments with respect to claims 21-40 have been considered but are moot in view of the new ground(s) of rejection.

In the remarks of 12/14/2005, applicant traverses the rejection under 35 U.S.C 103. The traversal is based on the ground that the surveillance receiver both monitor the call. This argument is not found to be persuasive because the limitation argued by applicant is not cited in the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant also argues that reference does not teach gate controller and gate open message. This argument is not found to be persuasive . Applicant's attention is directed at column 3 lines 53-57 and column 7 lines 55-58 wherein it teaches the gate control message.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T TON whose telephone number is 703-305-4739. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton

DANG TON
PRIMARY EXAMINER